

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Pilux & Danpex, S.A.

Serial No.: 10/537,183

Filed: October 5, 2004

For: Fluorescent Lamp Reflectors

Customer Number: 07617

Attorney Docket No.: 2626

T.C./Art Unit: 2875

Examiner: Jessica L. McMillan

Date of this document: March 26, 2009

Box DAC
Assistant Commissioner for Patents
Washington, DC 20231

STATEMENTS ESTABLISHING UNINTENTIONAL DELAY

Sir:

Applicant submits the following statements establishing unintentional delay. These statements are supported by the accompanying Declaration of Antonios Paravantsos (hereinafter, "AP Dec.").

Filing of Application

On June 2, 2005, Applicant filed the subject application that is directed to a reflector made of a thin, flexible, synthetic material to be fixed directly onto the glass envelope of a fluorescent lamp. The subject reflector allows significant energy savings by directing light to a desired workspace and, due to its simplicity of design, is economical (energy-efficient) to manufacture. AP Dec. ¶ 2.

UL Safety Certification Refusal

In September of 2005, Applicant, a Greek company with its offices in Greece (AP Dec. ¶ 1), requested that an external associate for Underwriter Laboratories, Inc. ("UL") of the United States investigate and certify the reflector in accordance with the existing UL safety standards. AP Dec. ¶ 3 & Exh. A. UL is a major organization in the U.S.A. that certifies the safety of products (AP Dec. ¶ 4 & Exh. B: "21 billion UL marks appearing * * * annually"). In particular, UL certifies the safety of electrical lighting products in the U.S.A. (AP Dec. ¶ 4 & Exh. C). A UL Listing Mark certifying the safety of electrical products appears as follows:



AP Dec. ¶ 5 & Exh. D. Regarding the foregoing UL Listing Mark, UL states:

The UL Listing Mark is one of the most common UL Marks. If a product carries this Mark, it means UL found that representative samples of this product met UL's safety requirements. These requirements are primarily based on UL's own published standards for safety. This type of Mark is seen commonly on appliances and computer equipment, furnaces and heaters, fuses, electrical panel boards, smoke and carbon monoxide detectors, fire extinguishers and sprinkler systems, personal flotation devices like life jackets and life preservers, bullet resistant glass, and thousands of other products. [*Id.*]

The external associate of UL, WILGER TESTING COMPANY, reported to Applicant that its investigation showed that the reflector of the subject application did not comply with certain clauses of UL Standard UL1598B, and therefore the safety of the reflector could not be certified by UL. AP Dec. ¶ 6 & Exh. A (see "UL 1598B" Clauses 3.2 – 3.4). For instance, the reflector did not meet the requirement of UL 1598B Clause 3.3, which states, "Fluorescent lamps shall not be relied upon for support of any reflector kit component." *Id.* However, the subject reflector depends is entirely supported by a fluorescent lamp (AP Dec. ¶ 6), directly contrary to the foregoing UL 1598B Clause 3.3.

A UL Listing makes it possible to market lighting (and other products) nationwide, which was Applicant's intention when seeking a patent on the subject application. AP Dec. ¶ 7. As UL states on its website, "If you plan to market your product nationally or internationally, it is advisable to obtain UL Listing." AP Dec. ¶ 7 & Exh. E. As UL states, this is because, "In the U.S. there are many municipalities that have laws, codes or regulations which require a product to be tested by a nationally recognized testing laboratory before it can be sold in their area." *Id.* Accordingly, it is a common belief¹ that having UL Listing on a product is vital to open up a national market.² In all of 2006-2008,

¹ The various references to UL and Wikipedia websites provided herein are not intended to prove the truth of the matters asserted in these websites, but rather is submitted to show that these statements were publicly made so as to result in a common belief by Applicant and others that these statements are true.

² For instance, a Wikipedia article states that:

In practice, however, it may be extremely difficult to sell certain types of products without a UL Mark. Large distributors may be unwilling to carry a product without UL certification, and the use of noncertified equipment may invalidate insurance coverage. It is common practice in many fields to specify UL Listed equipment or UL Recognized materials. Local jurisdictional authorities, such as building, electrical and fire inspectors, may be reluctant to accept a product for installation in a building unless it carries a recognized third-party compliance mark such as the UL Mark. AP Dec. ¶ 7 & Exh. F.

Applicant was only able to sell a quantity of its product in the U.S.A. in February of 2008 that was miniscule in relation to the potential national market.³ J.P. Dec. ¶ 7.

Further, a considerable number of the largest retail chain stores in the U.S. have “partnered” with Underwriters Laboratories, Inc. (UL) to reach consumers with messages concerning product safety. Such retail chain stores include Sears, Ace Hardware, Do It Best, Home Depot, Lowes Home Improvement, Menards, Sam’s Club and Target (AP Dec. Exh. G). All of these large retailers sell cylindrical fluorescent lamps, or luminaires for such fluorescent lamps, and so all of these retailers could readily sell the subject reflector as an accessory for such fluorescent lamps (AP Dec. ¶ 8). Applicant believes that sales of the subject reflector to such large retail chain stores—either for use by the stores themselves or for resale to buyers—would be severely restricted without a UL Listing. AP Dec. ¶ 8.

Potential Patent Right Eviscerated by UL Refusal to Certify

The potential right in a patent application is the right that will accompany any patent that is issued. A core expression of that right appears in 35 USC 271 (a), which states: “Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”

Without a UL Listing, Applicant believed that the potential market in the U.S.A. for the subject reflector would be severely restricted for any company. This, in turn, would severely restrict the ability of anyone else to use, offer to sell or sell the same type of reflector in the U.S.A., and at the same time severely restrict the likelihood of infringement of the foregoing patent rights. AP Dec. ¶ 9. With any infringement severely restricted and the cost of a patent infringement suit very high,⁴ obtaining a patent on the subject application that would give Applicant the right to sue for infringement would be,

³ In February 2008, Applicant sold 50,400 reflectors to a grocery store chain, with a net profit of only about 35200€ (approx. USD \$48,000), which is trivial in comparison with the national market effectively foreclosed by UL’s refusal to certify safety of the reflector; that is, less than about 0.015 percent of the projected national market. J.P. Dec. ¶ 7.

⁴ For instance, the American Intellectual Property Law Association Report of Economic Survey 2007 reports a median cost for a patent infringement suit in the U.S.A. at \$600,000 for less than \$1 Million at stake. (AP Dec. ¶ 10 & Exh. H.)

for practical purposes, meaningless.⁵ This is what Applicant believed in light of UL's refusal to certify the safety of its reflector. AP Dec. ¶ 9.

Non-Response to Office Action and Notice of Abandonment

Accordingly, Applicant did not respond to the Office Action in the subject application dated November 6, 2006, informing the undersigned patent attorney (who was prosecuting the application) on February 12, 2007 of the "non-acceptance by the UL Laboratory of the U.S.A. of the way the reflector is supported on the fluorescent lamp." (AP Dec. ¶ 11 & Exh. I.) Similarly, Applicant did not respond to the Notice of Abandonment dated June 4, 2007. However, in doing so, Applicant did not intend to abandon a meaningful patent right in the patent application. As discussed above, this is because the potential property right was, for practical purposes, eviscerated by UL's refusal in 2006 to certify the safety of the reflector disclosed and claimed in that application. As such, there was nothing meaningful for Applicant to abandon.

Reason to Seek Revival Now: Activities in Europe and Middle East

Apart from the U.S. market that was foreclosed by UL's refusal to certify the safety of the subject reflector, Applicant has sold the subject reflector of the present application in other markets. AP Dec. ¶ 12. As a byproduct of selling in other markets, Applicant believes that, serendipitously it has now acquired sufficient safety data on its reflector from those other markets to seek a waiver of the subject UL 1598B standard discussed above. AP Dec. ¶ 12.

One step taken by Applicant to sell its reflector in Europe was to seek certification of the subject reflector by the Austrian Electrotechnical Association (TGM) in accordance to European Standard EN60598, which applies to this range of products. Certification of our product was in fact issued by TGM on or about 7 September of 2006. (AP Dec. ¶ 13 & Exh. J.) Although the attached certification is partly in German, the front page states in English, "synthetic reflector named RSK suitable for all T8 lamps with 1,2 m."

⁵For instance, the net profit of only about USD \$48,000 from Applicant's limited sales in the U.S.A. as mentioned above in note 3 is far too little for anyone to justify bringing an infringement suit with a median cost of \$600,000, and further is far too low to attract a law firm to bring a patent infringement suit with a fee to be paid contingent on obtaining (tiny) damages from a patent infringer.

The difference between the European Standard EN60598 certified as met by TGM as mentioned just above and the applicable UL Standard UL1598B mentioned above is that the European ("EN") standard approves mounting of a reflector or other part directly onto the glass envelope of a lamp, as long as the weight of the part does not exceed 500 gr. AP Dec. ¶ 14 & Exh. K (EN 60598-01 standard). The subject reflector can be made to readily meet this weight standard. AP Dec. ¶ 14. The UL standard on the other hand does not accept any part to be mounted directly onto the glass envelope of a fluorescent lamp, regardless of the lightness of the weight of the part. AP Dec. ¶ 14 & Exh. J (UL 1598B standard).

At the present time, Applicant has serendipitously determined that sales of the subject reflector outside of the U.S.A. has resulted in sufficient data to enable it to seek from Underwriters Laboratories, Inc. (UL) of the U.S.A. a waiver of the applicable UL Standard UL1598B mentioned above. AP Dec. ¶ 15. These factors are:

1. Applicant has sold hundreds of thousands of the subject reflectors outside the U.S.A. (AP Dec. ¶ 15), with such reflectors conforming to the European Standard EN60598 mentioned above that requires the reflectors to be below specified weights. AP Dec. ¶ 15.
2. The subject reflector has been sold from 2006 to the present, enduring durability testing over time without safety incident. In more detail, from 2006 to 2008, approximately 460,000 of the subject reflectors were sold in Europe and the Middle East, with about 110,000 reflector units sold in 2006, 150,000 units in 2007 and 200,000 units in 2008. This accumulation of sales, some of which was two or more years ago, without safety incident constitutes a substantial body of evidence of durability testing over time. AP Dec. ¶ 15.

As a result of the foregoing, Applicant now has serendipitously accumulated a substantial body of evidence of the safety of the subject reflector that it believes will be a cogent basis to seek a waiver of the applicable UL Standard UL1598B that prohibits sales of the subject reflector. AP Dec. ¶ 16.

Conclusion

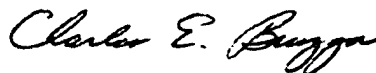
As detailed above, Applicant did not intentionally abandon any meaningful patent right in the subject application, because that right had already been eviscerated by UL. AP Dec. ¶ 17. Further, as detailed above, the delay between the Notice of

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Abandonment dated June 4, 2007 and the accompanying petition to revive the application was also unintentional. AP Dec. ¶ 17.

Dated: March 26, 2009

Respectfully submitted,

A handwritten signature in cursive script, reading "Charles E. Bruzga".

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